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10/015,957	12/13/2001	John Sheridan Richards	600.1175	6980

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EXAMINER

CULLER, JILL E

ART UNIT PAPER NUMBER

2854

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/015,957

Applicant(s)

RICHARDS, JOHN SHERIDAN

Examiner

Jill E. Culler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: stripper, 5, see page 7, line 9.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 16.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method of cutting folios from a fourth web and storing them relative to the first and second folios, as recited in claim 4, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

On page 1, line 5, the word "and" between "method" and "for" seems out of place. Possibly, the word "device" is missing between "and" and "for".

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On page 3, line 17, it appears that the phrase "so as two print two folios" should be "so as to print two folios" instead.

Appropriate correction and/or clarification is required.

### ***Claim Objections***

3. Claims 7 and 12 are objected to because of the following informalities:

In claim 7, on line 2, the recitation of "the second folio" has no antecedent basis.

In claim 12, on line 1, the recitation of "the print cylinder" has no antecedent basis.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 8, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,385,659 to Tornberg.

With respect to claim 1, Tornberg shows a method for combining folios between a first and a second web in a rotary printing press, the method comprising cutting a first folio from a third web, W-2, in the rotary press, see page 2, column 2, lines 53-55, storing the first folio on a storage device, see page 3, column 1, lines 49-72, and

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transferring the first folio from the storage device to a position between the first and second webs, see page 3, column 2, lines 56-64.

With respect to claim 3, Tornberg teaches moving the first, second, and third webs through the press at a same speed. See page 4, column 1, lines 11-15.

With respect to claim 8, Tornberg shows a device for combining folios between first and second webs in a rotary printing press, the device comprising a cutting cylinder, 97, configured to cut a first folio from a third web, W-2, a storing device in operative connection with the cutting cylinder, the storing device configured to store the first folio, see page 3, column 1, lines 49-68, and a positioning device, 119, adjacent the storing device configured to transfer the stored first folio from the storing device to a position between the first and second webs. See page 3, column 2, lines 20-28.

With respect to claim 16, Tornberg teaches the positioning device includes a belt, 119, mounted on a plurality of belt rollers. See page 3, column 2, lines 20-28.

With respect to claim 17, Tornberg shows a web product, moveable in a rotary printing press, the web product comprising, a first web, W, a second web, W-1, and a first folio cut from a third web, W-2, wherein the first folio is sandwiched between the first and second webs. See page 3, column 2, lines 61-64.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 9-10, 14, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornberg in view of U.S. Patent No. 4,381,106 to Loebach.

With respect to claims 2, 9-10, 14 and 18, Tornberg teaches all that is claimed, as in the above rejection of claims 1, 3, 8, 16 and 17, except that the method further comprises cutting a second folio from the third web, the storing step includes storing the second folio in a stacked relationship relative to the first folio on a precollect cylinder, and the transferring step includes simultaneously transferring the stacked first and second folios from the precollect cylinder. Tornberg also does not teach that the precollect cylinder includes grippers for holding the first and second folios against a circumference of the precollect cylinder.

Loebach teaches a method of combining folios on a precollect cylinder, 22, wherein a first folio and second folio are cut, stored in a stacked relationship on the precollect cylinder using grippers, and transferred simultaneously from the precollect cylinder. See column 4, lines 7-31.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the precollect cylinder method and device of Loebach in place of the storing device of Tornberg in order to be able to collect the folios in a stacked relationship and deliver them between the webs.

With respect to claim 20, Tornberg teaches that the transferred folios are aligned with a respective folio image of at least one of the first and second webs. See page 3, column 2, lines 67-69.

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8. Claims 4, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornberg in view of Loebach as applied to claims 2, 9-10, 14 and 18 above, and further in view of U.S. Patent No. 1,968,630 to Barber.

With respect to claims 4 and 19, Tornberg as modified by Loebach teaches all that is claimed as in the above rejection of claims 2, 9-10, 14, 18 and 20 except for cutting a third folio from a fourth web, cutting a fourth folio from a fourth web, storing the third and fourth folios in a stacked relationship relative to one another and relative to the first and second folios on a precollect cylinder, and transferring the stacked first, second, third and fourth folios simultaneously from the precollect cylinder.

There appears to be no unobviousness in performing a plurality of identical steps for achieving an identical product. It would have been obvious to one having ordinary skill in the art at the time of the invention to cut and store a fourth web, since the step is already known with respect to the third web. Furthermore, Barber teaches that it is known to cut and collect four webs onto a collecting apparatus.

With respect to claim 13, Tornberg, as modified by Loebach, teaches all that is claimed, as in the above rejection of claims 2, 9-10, 14, 18 and 20 except that the precollect cylinder includes pins for holding the first and second folios against a circumference of the precollect cylinder.

Barber teaches a precollect cylinder, 9, having pins for holding the folios against a circumference of the cylinder. See page 1, lines 72-76.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the precollect cylinder of Tornberg and Loebach to have

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pins, as Barber teaches this is an effective structure for holding folios against the cylinder.

9. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornberg in view of Loebach as applied to claims 2, 9-10, 14, 18 and 20 above, and further in view of U.S. Patent No. 4,564,470 to Schmitt.

Tornberg, as modified by Loebach, teaches all that is claimed as in the above rejection of claims 2, 9-10, 14, 18 and 20 except that the precollect cylinder has a circumference that is equal to a length of one of three folios, five folios and seven folios.

Schmitt teaches a precollect cylinder having a circumference equal to a length of three folios.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the precollect cylinder of Tornberg, as modified by Loebach, to have a circumference equal to a length of three folios, as Schmitt teaches this is a useful size for collecting and delivering folios.

10. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornberg in view of Schmitt.

With respect to claim 12, Tornberg teaches all that is claimed, as in the above rejection of claims 1, 3, 8, 16 and 17, except that a print cylinder includes a printing plate with at least two folio images arranged circumferentially.



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Schmitt teaches a print cylinder with a printing plate with at least two folio image arranged circumferentially. See column 4, lines 18-21.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Tornberg to have a print cylinder with at least two folio images arranged circumferentially because Schmitt teaches it is useful to print webs for associating using such a printing cylinder.

With respect to claim 6, Tornberg teaches all that is claimed, as in the above rejection of claims 1, 3, 8, 16 and 17, except that the cutting step is performed using a cutting cylinder having a circumference that is one-half a circumference of a printing cylinder.

It would have been obvious to one having ordinary skill in the art at the time of the invention that, using a printing cylinder having two folio images arranged circumferentially as taught by Schmitt, a cutting cylinder having a circumference one-half the circumference of the printing cylinder would be effective for cutting each folio.

Furthermore, the optimum dimension of the cutting cylinder could readily be determined by one of ordinary skill in the art through routine experimentation and does not appear to require any unobviousness.

11. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tornberg in view of U.S. Patent No. 4,015,837 to Ostler.

Tornberg teaches all that is claimed, as in the above rejection of claims 1, 3, 8, 16 and 17, except for providing an electrostatic charge to at least one of the first web,

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the second web, the first folio, or a second folio so as to enable an adhesion between the first and second folios and at least one of the first and second webs.

Ostler teaches providing an electrostatic charge to a paper web so as to enable an adhesion between the web and folios to be attached to it. See column 2, lines 18-23.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Tornberg using the electrostatic charge device of Ostler in order to cause the folios to better adhere to the webs as they are associated.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 405,016 to Crowell, U.S. Patent No. 1,748,988 to Morris, U.S. Patent No. 1,909,518 to Boyce and U.S. Patent No. 2,600,284 to Tranter each teach a device for handling folios having obvious similarities to the claimed subject matter.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (703) 308-1413. The examiner can normally be reached on M-Th 7:30-5:00.

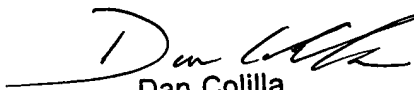
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

jec  
April 7, 2003



Dan Colilla  
Primary Examiner  
Art Unit 2854